

REMARKS

Claims 1-14 are pending in the present application. Claims 1, 4, and 13 are amended to address minor informalities. Applicant acknowledges the withdrawal of the previous requirement for election.

The Election Requirement, allegedly based on PCT Rule 13.1 regarding unity of invention, requires the Applicant to elect a single species from each of the Election Requirement's sixteen (16) identified species A-P, each of A-P being associated with a separate figure of Applicant's disclosure. The Election Requirement sets forth a correspondence between the Claims and Figures/Species at page 3, paragraph 3. Further, the Election Requirement concludes that the identified species lack "the same or corresponding special technical features" because "they are drawn to a mutually exclusive combination of elements."

To expedite prosecution, Applicant provisionally elects, with traverse, to prosecute claims corresponding to Species I, with at least Claims 5, 8-9, and 13 readable thereon. It is further argued, however, that Claim 5 is generic with respect to at least Claims 6-7 depending therefrom, as well as Claims 10, 11, and 14. Thus the Applicant asserts that if Claim 5 is allowable, Claims 6-11 and 13-14 should be examined.

With specific reference to Claims 6-7 depending from Claim 5, PCT Rule 13.4 explicitly states:

"Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention."

Further, “unity of invention has to be considered in the first place only in relation to the independent claims” (MPEP 1850(II)). Accordingly, Claims 6-7 must be examined since they depend from Claim 5, corresponding to provisionally elected Species I.

Moreover, given the asserted Claim/Figure correspondence provided in the Election Requirement (for instance, asserting that Claims 6 and 14 correspond to Figures 16 & 21/Species E & H, that Claims 7 and 10 correspond to Figure 19/Species G, and that Claims 6 and 11 correspond to Figure 24/Species K), Claims 10, 11, and 14 must also be examined with Claims 6 and 7 on the basis of the Election Requirement itself.

Applicant respectfully requests the withdrawal of the erroneous requirement for election of species based on PCT Rule 13.1 regarding unity of invention.

At least two errors are present in the Election Requirement. First, the Election Requirement fails to properly follow PCT Rule 13 governing unity of invention. Second, the Election Requirement fails to provide any description or suggestion to support its finding of lack of unity of invention and sixteen (16) species A-P.

First, although the Election Requirement is based on Rule 13, it fails to properly follow the PCT Rule governing unity of invention as described at MPEP 1850 and 1893.03(d). MPEP 1850, applicable to the national stage, explains that the “special technical feature” inquiry of Rule 13.2 requires a consideration of novelty and inventive step. Although the guidelines also require “a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or ... any additional document considered to be

relevant,” no such consideration is articulated or even suggested in the Election Requirement (MPEP 1850(II)) despite the citation in the submitted ISR of references regarding the general state of the art. Further, when lack of unity of invention is not clear, the guidelines also promote “the benefit of any doubt being given to the applicant.” (MPEP 1850(II)). The Election Requirement asserts lack of unity of invention without any suggestion that the proper inquiry was undertaken in identifying sixteen (16) Species A-P. Accordingly, the Election Requirement assertion is improper.

Second, the Election Requirement fails to state or even suggest the required explanation supporting an assertion of lack of unity of invention, instead improperly basing the requirement mutual exclusivity. MPEP 1893.03(d), describing unity of invention during the national stage, explicitly directs that “the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group ... specifically describing the unique special technical feature in each group.” The Election Requirement fails to state or even suggest a unique special technical feature in each of groups/Species A-P supporting the assertion of lack of unity of invention. Instead, the Election Requirement cites a conclusory statement of mutual exclusivity as its sole support. In addition to the Election Requirement’s lack of explanation regarding the asserted mutual exclusivity, it is noted that mutual exclusivity is not the test advocated by PCT practice. Instead, when the Office considers national applications during the national stage under 35 U.S.C. 371, PCT Rules 13.1 and 13.2 will be followed without regard to the practice in national applications filed under 35 U.S.C. 111 (MPEP 1850(I)). The proper test for determining unity of invention can be found at MPEP

1850(II). Accordingly, the Election Requirement insufficiently applies an improper test to support its finding of lack of unity of invention.

Lastly, it is further noted that the International Search Authority, Japan, did not find lack of unity of invention among Claims 1-14 and proceeded to search all 14 claims.

Thus, the requirement for election of species based on PCT Rule 13.1 is improper and must be withdrawn.

By distinctly and specifically pointing out grounds of error in the election of species requirement, Applicant's provisional election with traverse preserves Applicant's right to petition the Director to review this requirement.

In view of the improper and incomplete election of species requirement on the grounds discussed above, reconsideration and withdrawal of the election of species requirement and examination of all claims is earnestly solicited.

Respectfully submitted,



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